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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,443	02/11/2002	Gordon Simms	GS 02014	4479

7590 03/12/2004

JAMES RAY & ASSOCIATES  
2640 Pitcairn Road  
Monroeville, PA 15146

EXAMINER
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CHANG, YEAN HSI

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,443

Applicant(s)

SIMMS, GORDON

Examiner

Yean-Hsi Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9-11, 13-15 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 5, 8, 12 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 10, 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by DiOrio (US 6,357,703 B1).

DiOrio teaches an apparatus for securing a mouse support pad (24, fig. 4) to a predetermined member (18, fig. 3), comprising:

- A vertical member (42, fig. 3) having a predetermined size and shaped (shown in fig. 3), and a first end (lower end of 42, fig. 3, not numbered) and a second end (upper end of 42, fig. 3, not numbered) (claims 1 and 10)
- A slot (between members 44 and 46, fig. 4, not labeled) disposed within said vertical member intermediate said first end and said second end of said vertical member being closely adjacent said first end of said vertical member so that said vertical member extends upwardly from an upper surface (upper surface of 18, fig. 3) of such predetermined member, and having a

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- predetermined width (shown in fig. 4) being sufficient to slide onto a desktop (18, fig. 3) (claims 1, 6, 10 and 17)
- A securement device (52, fig. 3) disposed on said first end of said vertical member for securing said vertical member to a predetermined member (18, fig. 3) (claims 1 and 10)
  - A means (50, fig. 4; see col. 6, lines 11-13) for securing the mouse support pad (24, fig. 4) to said second end of said vertical member (claims 1 and 10)
  - Wherein said securement device includes a bolt (52, fig. 10) being threadably attached to said first end of said vertical member and entering said slot of said vertical member (shown in fig. 3) (claims 2-4 and 13-15)
  - Wherein said mouse support pad is a solid platform made of plastic (see col. 5, lines 53-55) (claim 11)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiOrio.

DiOrio discloses the claimed invention except specifying the means for securing the mouse support pad to the second end of the vertical member are capscrews.

However, DiOrio teaches a set of fasteners (58, fig. 5) being capscrews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify the fastening means (50, fig. 4) being also capscrews for clearly indicating the fasteners used.

5. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiOrio.

DiOrio discloses the claimed invention except specifying the slot being disclosed between 0.25 inches and 0.5 inches from the first end of the vertical member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify the slot being disposed between 0.25 and 0.5 inches from the end of the vertical member and to indicate in fig. 3, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. See MPEP §2144.04, VI, A.

***Allowable Subject Matter***

6. Claims 5, 8, 12 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record, DiOrio (US 6,357,703 B1), fails to teach or reasonably suggest an apparatus for securing a mouse support pad to a predetermined member, comprising: a three star knob provided on a second end of a bolt of a securement device disposed on a first end of a vertical member for turning said bolt as set forth in claims 5 and 16; a slot disposed within said vertical member, having a ledge disposed in said slot as set forth in claim 8; and wherein said mouse support pad is a solid platform made of a phenolic resin as set forth in claim 12.

### ***Response to Arguments***

8. Applicant's arguments filed Feb. 17, 2004 have been fully considered but they are not persuasive. Applicant argues, "There is no teaching or even a suggestion in Diorio of having a vertical member that extends upwardly from the predetermined member or shelf." Diorio names the element 42 "a clamp" which is apparently a vertical member having all limitations claimed in the claims as indicated in paragraph 2, hereinabove.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

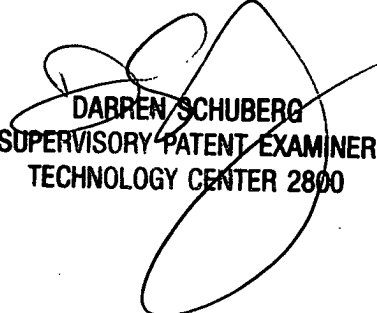
1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yean-Hsi Chang whose telephone number is (571) 272-2038. The examiner can normally be reached on 07:30-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the Art Unit phone number is (571) 272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431 for regular communications and for After Final communications. There are RightFax numbers and provide the fax sender with an auto-reply fax verifying receipt by the USPTO: Before-Final (703-872-9318) and After-Final (703-872-9319).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8558.

Yean-Hsi Chang  
Patent Examiner  
Art Unit: 2835  
March 5, 2004

  
DARREN SCHUBERG  
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